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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,589	02/06/2004	Nokihisa Adachi	428291/0024	8964

7590 08/07/2006  
Lawrence Rosenthal  
Stroock & Stroock & Lavan LLP  
180 Maiden Lane  
New York, NY 10038

EXAMINER

NGUYEN, PHONG H

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/773,589

Applicant(s)

ADACHI ET AL.

Examiner

Phong H. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art, hereinafter AAPA, in view of Shinomiya et al. (4,506,577), hereinafter Shinomiya.

Regarding claims 1 and 3, AAPA teaches a method for controlling a slitter apparatus comprising the steps of:

supplying a paperboard sheet along a feed line; and

moving the slitter in a vertical direction and a widthwise direction.

See the Specification from page 1, line 10 to page 3, line 8.

The slitter moves out of the paperboard vertically as the slitter is between the top surface and the bottom surface of the paperboard.

AAPA does not teach a diagonal movement of the slitter to a second cutting location after the vertical movement of the slitter. Shinomiya teaches a diagonal movement of a slitter to a second cutting location after the step of pulling the slitter out of the paperboard. See Figs. 1-3 and cols. 3-4, lines 32-6. Therefore, it would have been obvious to one skilled in the art to incorporate the step of moving the slitter diagonally to the second cutting location after it is pulled out of the paperboard (or in other words, after the vertical movement in AAPA) as taught by Shinomiya to the method of AAPA for reducing the traveling time of the slitter.

Regarding claims 5 and 6, the combination of AAPA and Shinomiya teaches the invention substantially as claimed except whether the moving path of slitter forms a plurality of straight lines or a curve. The shapes of the moving path depend on the speed of the vertical movement and the horizontal movement of the slitter and are obvious variants since they do not solve any stated problem. Since one of the shapes of the moving path is inherently in the combination of AAPA and Shinomiya, varying the speed of the vertical movement and the horizontal movement of the slitter to get the other shape of the moving path is routine skilled in the art. Therefore, it would have been obvious to one skilled in the art to select any desired speed for the vertical movement and the horizontal movement so that the moving path of the slitter forms lines or a curve since such practice is routine skill in the art.

Regarding claim 7, see AAPA.

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3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Shinomiya as applied to claims above, and further in view of Japanese Patent Publication H8-11245, hereinafter JPP 11245.

The combination of AAPA and Shinomiya teaches moving the slitter vertically out of the paperboard, moving the slitter horizontally to a predetermined position between a first cutting location and a second cutting location, and moving the slitter diagonally to the second cutting location. The combination of AAPA and Shinomiya fails to teach the step of moving the slitter diagonally while it is in the paperboard. JPP 11245 teaches that a slitter can be moved laterally while it is in a paperboard. Therefore, it would have been obvious to one skilled in the art to move the slitter diagonally to the predetermined position after it is partially pullout from the paperboard to reduce the traveling time of the slitter since JPP 11245 teaches that a slitter can be moved laterally while it is in a paperboard.

#### ***Response to Arguments***

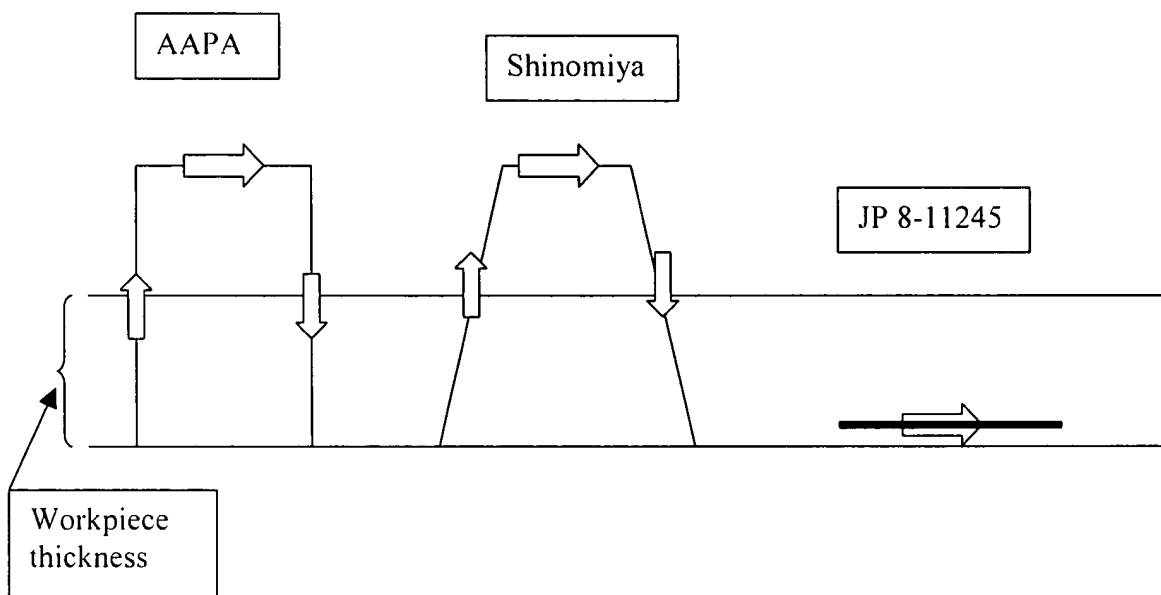
4. Applicant's arguments filed on 06/09/2006 have been fully considered but they are not persuasive.

Applicant argues against the references individually while the rejections are based on a combination of references. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800

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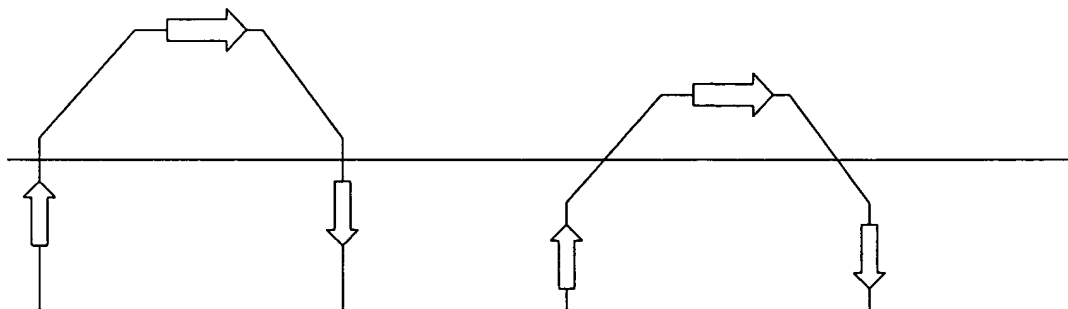
F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The combination of AAPA, Shinomiya and JP 8-11245 reads on the claimed invention as shown below.

Traveling paths of each individual reference as arguing by the Applicant



Traveling paths of the combination of AAPA, Shinomiya and JP 8-11245

Or



***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

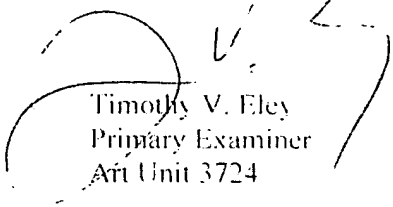
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phong H. Nguyen whose telephone number is 571-272-4510. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

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more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Timothy V. Eley  
Primary Examiner  
Art Unit 3724

PN:



July 28, 2006